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EXAMINER	
FISCHMANN, BRYAN R	
ART UNIT	PAPER NUMBER

3618

DATE MAILED: 12/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/088,313	Applicant(s) BACHMANN, MAX	
	Examiner Bryan Fischmann	Art Unit 3618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 30-47 (as renumbered) is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 30-47 (as renumbered) is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 March 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

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Acknowledgments

1. The Drawing Corrections (paper 6), Substitute Specification (paper 7) and the Amendment (paper 8) filed 9-22-2003 have been entered.

Renumbering of Claims

2. Note that paper 8 submits claims 30-48. However also note that there is no claim 39.

37 CFR 1.126 recites "The original numbering of the claims must be preserved...When claims are canceled, the remaining claims must not be renumbered...When claims are added, they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented"

Accordingly, new claims 40-48 have been renumbered 39-47. See Section 608.01(j) of the MPEP.

Specification

3. The abstract of the disclosure is objected to because of the following:
 - A) The abstract recites "By arranging the reduction steps (3, 11) directly adjacent to one another, a uniform temperature is established...". The meaning of this recited phrase, particularly what "temperature" is being referred to, and how a "uniform temperature" is affected by the location of the "reduction steps" is considered unclear.
4. The disclosure (paper 7) is objected to because of the following:

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A) The following recited phrases are unclear, awkwardly worded, and/or grammatically incorrect:

1) The recitation of "...which is compactly designed in axial extension..." in paragraph 007 is considered unclear.

2) The recitation of "...can be more compactly designed in extension..." in paragraph 010 (middle of page 3 of paper 7) is considered awkward.

3) To improve wording, it is believed that the word "a" should be present before the word "double-shear" in paragraphs 014 and 015.

4) To be grammatically correct, it is believed that the word "defining" should instead be "defines" in paragraph 017 in the middle of page 4 of paper 7.

5) In paragraph 017, on the last line of page 4 of paper 7, it is believed that to be grammatically correct that the word "bearing" should be plural.

6) In paragraph 017, on the seventh line of page 5 of paper 7, the word "the" is misspelled as "th".

7) In paragraph 017, toward the lower portion of page 5 of paper 7, the meaning of the word "table support" is considered unclear.

8) In paragraph 017 on the fourth to the last line of page 5 of paper 7, to be grammatically correct, it is believed that the word "remain" should be plural.

9) It is still unclear to the Examiner how Figure 2 differs from Figure 1. Note that paragraph 015 describes Figure 2 as a "second embodiment". Due to this, it is requested that the "title" of paragraph 018 be changed from "Fig. 2" to something more descriptive, such as "Description of the second embodiment of the invention", or

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similar, and that paragraph 018 clearly set forth the differences between Figures 1 and 2, if there are actually any. If there are not any differences between Figures 1 and 2, then Figure 2 should not be described as a "second embodiment" in paragraph 015.

10) The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required:

Claim 30 recites "...the disk brake (15) forming a stop which limits further insertion of the drive motor (1) within the rim (12)".

See also a similar recitation in claims 46 and 47 (as renumbered).

Claim 42, as renumbered, recites "...an input shaft (2) of the first reduction gear (3) has a winding recess which supplies lubricant to a motor bearing (20) upon rotation of the input shaft (2)".

The Examiner cannot find support for this recitation in the disclosure.

Drawings

5. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the input pinion of the first reduction gear meshing with at least two intermediate wheels of the first reduction gear as recited in claim 43, as renumbered, must be shown or the feature canceled from the claim. No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

6. Claims 30-46 (as renumbered) are objected to because of the following:

A) To improve wording, it is believed that the word "an" should be inserted before the word "actuation" in line 7 of claim 30.

B) Claim 37 recites "brake disk". To be consistent with claim 30, from which claim 37 depends, the recitation of "brake disk" should instead be "disk brake".

See also claim 46 for a similar objection.

C) To improve wording, it is believed that the word "with" should be inserted after the word "meshes" in line 2 of claim 43.

D) The term "skewed bearing" in claim 45 is considered a bit awkward and non-descriptive. For example, the term "skewed bearing" could imply that the bearing housing is installed "skewed" to the longitudinal axis of the wheel and motor axes, as opposed to an internal component of the bearing being "skewed".

E) To improve wording, the recitation of "an shaft" in line 2 of claim 46 should instead be "a shaft".

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 30-47 (as renumbered) are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claim 30 recites "...the disk brake (15) forming a stop which limits further insertion of the drive motor (1) within the rim (12)".

Note that independent claims 46 and 47 contain similar recitations.

The above recitation is considered new matter due to the following:

(a) The Examiner cannot find support in the original disclosure for this recitation.

Note instead that the original drawings appear to show an axial clearance between the drive motor housing (1) and the brake disk (15) and that the axial location of the motor further inward is instead limited by the wheel hub (9) to which the drawing figures show the drive motor (1) is bolted to. Due to this, the wheel hub would appear to axially locate the drive motor, as opposed to the brake.

(b) It is noted that claim 16 of Preliminary amendment "A" (paper 4), which was filed on the same day as the Instant Application, recites "...the axial extension of said drive motor (1) being limited by the brake disk (15) and an actuation mechanism (23) of said brake.

It is believed that claim 30 is a "rewrite" of claim 16.

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However, claim 16 does not appear to offer adequate written description for the above claim 30 recitation due to the following:

(1) It is not clear that the words "further insertion" recited in claim 30 are synonymous with the term "axial extension" recited in claim 16. Note also that the word "stop", which is used in claim 30, was not used in claim 16. Also note that the actuation mechanism would appear unrelated to the axial location of the drive motor, since the actuation mechanism is located radially outboard of the drive motor. Note that claim 16 teaches that the actuation mechanism also limits the "axial extension" of the drive motor.

(2) Also note that the first Office Action (paper 5) rejected claim 16 under 35 USC 112 2nd paragraph as being unclear, with specific reference being made to the above claim 16 limitation. Now that the Applicant has apparently clarified the meaning of this claim 16 limitation in claim 30, rejection of claim 30 under 35 USC 112 1st paragraph now seems appropriate for reasons already set forth in this Office Action.

Note that per Section 2163.06 of the MPEP, new matter in the claims should be rejected under 35 USC 112 first paragraph, written description requirement.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 43 and 44 (as renumbered) recite the limitation "the wheel bearing" in line

1. There is insufficient antecedent basis for this limitation in these claims.

Response to Applicant's Remarks (paper 8) and Examiner's Comments

11. The Substitute Specification (paper 7) resolved many specification objections made on the first Office Action (paper 5). However, as noted, additional objections are noted concerning the substitute specification.

12. The drawing corrections (paper 6) resolved all drawing objections made on the first Office Action.

13. All claim objections and rejections are rendered moot by amendment, since all previous claims have been canceled and a new set of claims have been submitted. Additionally, Applicants comments concerning the rejection of claims 16-29 as being unpatentable over Baker are also considered moot, since all claims have been canceled and a new set of claims have been submitted.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- A) Baker ('751) – teaches a motor-driven wheel assembly
- B) Carini – teaches a motor-driven wheel assembly
- C) British Patent 2201386 – teaches a motor-driven wheel assembly
- D) British Patent 2294984– teaches a motor-driven wheel assembly
- E) Japanese Patent 316828 – teaches a motor-driven wheel assembly
- F) Japanese Patent 515178 – teaches a motor-driven wheel assembly
- G) Japanese Patent 648192 – teaches a motor-driven wheel assembly

16. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Bryan Fischmann whose telephone number is (703) 306-5955. The examiner can normally be reached on Monday through Friday from 7:30 to 4:00.

If attempts to reach the Examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson, can be reached on (703) 308-0885. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

 11-24-03
BRYAN FISCHMANN
PATENT EXAMINER